

REMARKS

Claims 1-17 were pending in this application.

Claims 1-17 have been rejected.

No claims have been amended.

Claims 18-20 have been added.

Claims 1-20 are now pending in this application.

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1-10 and 12-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,745,574 to Muftic (“*Muftic*”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Muftic recites a public key infrastructure for providing security in a computer system. (*Abstract*). The infrastructure includes a hierarchical certification system and a repository. (*Col. 5, Lines 19-50*). The repository stores information such as public key certificates and revocation lists.

(Col. 5, Lines 41-54). Each of the computers in the infrastructure is capable of storing, among other things, public key certificates and revocation lists. (Col. 6, Lines 33-38). In operation, the public key certificates may be obtained from the repository or the computers, and the public key certificates are verified against one or more of the revocation lists. (Col. 7, Lines 4-10).

The cited portions of *Muftic* simply recite that public key certificates are compared against revocation lists to determine if the public key certificates are valid. The cited portions of *Muftic* lack any mention of using a “contact list” in conjunction with a “revocation list” to determine which devices or entities in the infrastructure are allowed to communicate with another device or entity. Also, the cited portions of *Muftic* contain absolutely no mention of using a “contact list” that contains information identifying the devices or entities that have attempted to contact another device or entity.

Because of this, the cited portions of *Muftic* fail to anticipate a “contact list” associated with a “given entity” or “device” that contains information identifying “one or more other entities which have attempted to communicate” with the “given entity” or “device” as recited in Claims 1, 16, and 17. In addition, the cited portions of *Muftic* fail to anticipate using the contact list “in conjunction with a revocation list” to “determine which of at least a subset of the one or more other entities are authorized to communicate” with the “given entity” or “device” as recited in Claims 1, 16, and 17.

For these reasons, the Office Action fails to establish that *Muftic* anticipates all elements of Claims 1, 16, and 17 (and their dependent claims).

Regarding the dependent claims, the dependent claims are patentable due to their dependence from allowable base claims and in light of their own recitations. For example, Claim 5 recites that

the contact list includes a “plurality of entries,” where each entry includes an “identifier of a particular one of the other entities” and a “corresponding revocation flag indicating whether authorization of the particular entity has been revoked.” The cited portions of *Muftic* lack any mention of a list that contains both an “identifier” of another entity and a “corresponding revocation flag” as recited in Claim 5. As a result, the Office Action fails to establish that *Muftic* anticipates all elements of Claim 5.

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1-10 and 12-17.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Muftic* in view of U.S. Patent No. 5,832,206 to De Jesus et al. (“*De Jesus*”). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

As shown above in Section I, Claim 1 is patentable. As a result, Claim 11 is patentable due to its dependence from an allowable base claim.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claim 11.

III. NEW CLAIMS

The Applicants have added new Claims 18-20. The Applicants respectfully submit that no new matter has been added. The Applicants respectfully request entry and full allowance of Claims 18-20.

IV. CONCLUSION

The Applicants respectfully assert that all pending claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date: _____

July 8, 2024



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